

ml



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,711	07/05/2001	Dana Corbo		4051

7590 07/13/2004

STEPHEN E. FELDMAN, P.C.
12 East 41st Street
New York, NY 10017

EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,711

Applicant(s)

CORBO, DANA

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 10-24 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to because of the issues noted on the attached Notice of Draftsperson's Patent Drawing Review. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3714

3. Claims 1-3, 6-8, 11-13, 22-24, 27 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Don Best Sports in view of Brenner et al. (US Patent Number 5,830,068).

Claims 1, 6, 11, 22, 27: Don Best Sports provides sporting event odds and information for sports books in substantially real time. The DBS2K program uses the Internet to provide real time odds and information. The program is incapable of placing bets. Don Best Sports provides a means downloading and storing to the user's computer information about occurrences in connection with odds, analyzing the information and alerting the user when a predetermined occurrence takes place in connection with the odds. (Line Move Alerts.) Don Best Sports provides a means for logging and tracking bets. (Bet Tracker) Don Best Sports offers a Line Seeker feature that provides an alert when predetermined odds on a particular game are offered by a sports book enabling the user to get the information needed automatically. It provides a means for display of this information (i.e., computer monitor). There is a means for navigating the display in order to acquire information – see DBS Premium Service sample page. This navigation means is a menu made up of various menus made up of various buttons equipped with pull down menus and, for any particular game or bet, the program is capable of visually cycling through odds from different sports books. Applicant admits that Don Best Sports allows for the display of odds to be manipulated for more efficient use.

Don Best Sports appears to use a web browser as the user interface. Use of purpose built programs as a user interface is notoriously well known in the art. Use of purpose built programs allows the author of the program to control the look and feel (i.e., usability and design features) of the user interface. Brenner teaches but one example of a

Art Unit: 3714

purpose built user interface used in a sports betting environment. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Don Best Sports in view of Brenner to use a non-web browser user interface in order to have greater control over the look and feel and usability of the user interface.

Claims 2, 23: Don Best Sports offers a Line Seeker feature that provides an alert when predetermined odds on a particular game are offered by a sports book.

Claims 3, 24: Don Best Sports provides a Line Move Feature that provides notification when the odds offered by a sports book change by a predetermined amount within a predetermined amount of time.

Claims 28: The DBS Premium Service sample page shows a menu made up of various buttons and the buttons are equipped with pull down menus.

Claim 7: Don Best Sports Bet Tracker allows the user to enter a bet and bet amount and provides a means for determining whether the bet was won or lost.

Claim 8: Don Best Sports Bet Tracker calculates and logs winnings and losses.

Claim 12: The DBS Premium Service sample page shows the display of casino columns. These appear to be customizable in that the user can choose to display different casino columns.

Claim 13: The DBS Premium Service sample page shows horizontal and vertical scrolling bars.

4. Claims 5, 10, 21, 26, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Don Best Sports and Brenner as applied to claim 1, 6, 11, 22, or 27 above, and further in view of Zinda et al. (US Patent Number 6,393,437).

Art Unit: 3714

Claims 5, 10, 21, 26, 29: Don Best Sports and Brenner teach the invention substantially as claimed. According to Applicant's disclosure, Don Best Sports is written in Java and not in C++. Java and C++ are extremely well known equivalents. Zinda, a patent concerning web development techniques, teaches that either language may be used to develop web-based applications. (Col 4, 7-11) It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the C++ programming language instead of its well know equivalent Java in order to achieve the same functionality.

5. Claims 14-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Don Best Sports and Brenner as applied to claim 11 above, and further in view of the Human Factors Design Guide.

Claim 14: Don Best Sports and Brenner teach the invention substantially as claimed, but do not specifically teach a feature that turns a page every five seconds. The Human Factors Design Guide (page 8-46) states, "if automatically changing data must be read reliably and accurately, the rate of update should not be more than once per second." It would have been obvious to one of ordinary skill in the art at the time of the invention to have turned the page every five seconds in order to allow the information to be read reliably and accurately.

Claims 15 & 18: Don Best Sports and Brenner teach the invention substantially as claimed but do not specifically teach using a color-coded display. The Human Factors Design Guide (page 8-50) states that color-coding (including highlighting) should be used to direct a user's attention to something. It would have been obvious to one of

Art Unit: 3714

ordinary skill in the art at the time of the invention to have used color-coding or highlighting to direct the user's attention to the display of odds.

Claim 16: Don Best Sports & Brenner teaches the invention substantially as claimed but do not specifically teach moving the casino column by the click and drag method. The Human Factors Design Guide (page 8-62) teaches the click and drag method of moving windows. This allows the user to take advantage of the pointing device (mouse) to move the window. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the click and drag method to move the casino columns in order to allow the user to take advantage of the pointing hardware.

Claims 17 & 19: Don Best Sports and Brenner teach the invention substantially as claimed but do not specifically teach resizing the casino columns to a custom setting. The Human Factors Design Guide (page 8-62) teaches allowing the user to resize windows. This allows the user to make the window the size the user prefers – including abbreviating the window to allow more windows to be displayed (i.e., more columns per page). It would have been obvious to one of ordinary skill in the art at the time of the invention to have allowed the user to resize the casino columns (including abbreviating the column to allow more columns to be displayed per page), so that the user can make the windows suit the user's preferences.

Response to Arguments

6. Applicant's arguments filed 27 April 2004 have been fully considered but they are not persuasive.

Art Unit: 3714

7. There is apparently some confusion concerning the term “user interface”. Don Best I (the reference used in the rejection) provides the underlying functionality of providing the claimed betting information. Applicant argues that Don Best I provides this information via the Internet (i.e., using a web browser interface). Applicant further argues that the patentable point of distinction between Don Best I and the instant invention is that the instant invention provides the same betting information using a dedicated program as a user interface instead of a web browser. The Examiner believes that the prior art renders this change in user interfaces obvious.

8. Applicant argues that changing the user interface renders the Don Best I reference unsatisfactory for its intended purpose. This is not persuasive for a number of reasons.

a. First, as repeatedly pointed out, the support for Applicant’s argument is based on a Declaration that is not in evidence. As discussed in previous office actions, this Declaration has never been timely filed. It cannot be used as evidence unless and until the timely and correctly filed in accordance with the provisions of the MPEP §716.01.

b. Even if the Declaration were in evidence it would neither be persuasive, nor particularly credible. Applicant’s argues that the “purpose” of Don Best I is to provide information without leaving traces on the computer. Yet Don Best I was designed and marketed as an essential tool for licensed bookmakers. A licensed bookmaker receives a license from the state. It is a matter of public record that the licensed bookmaker is engaged in this business. Clearly, a licensed bookmaker has no reason to “cover his tracks”.

The only type of bookmaker who would need to have access to this betting information without storing the data on his computer would be an unlicensed bookmaker

(i.e., a felon). Examiner does not believe that Applicant designed and marketed a program with the **sole purpose** of furthering a criminal conspiracy to violate various state and federal laws. Examiner declines to believe that Applicant is a racketeer.

Furthermore, even if Applicant inadvertently sold his product to an unlicensed bookmaker, Don Best I would still leave traces on the user's computer. Applicant can readily ascertain the truth of this assertion by examining his web browser's history list, the cookies stored on the computer, the cached web pages stored on the computer, etc. When web pages such as Don Best I are downloaded to a computer, traces of that data are stored on the computer. Thus, as a technical matter, Don Best I could not have fulfilled the "purpose" Applicants wants to argue it had.

Examiner also notes that if this were a critical feature of the program, surely some mention of this fact would have been included in the advertising material used to solicit sales. Examiner finds no mention of this feature in Applicant's sales literature.

All of these factors suggest that if the Declaration were in evidence, it would not overcome the references. The issue is, however, moot because the Declaration is not in evidence and cannot be considered.

c. Examiner also believes that the primary purpose of Don Best I was to provide betting information. To the extent that Don Best I served that purpose, Don Best I may be used as teaching those functions.

9. Applicant makes an argument that if the Applicant says that it would not have occurred to him to make the modifications to the prior art reference, then no such modification would be obvious to one of ordinary skill in the art. Applicant bases this on the fact that he developed the

Art Unit: 3714

prior art reference and he is, therefore, by definition “one of ordinary skill in the art”. This is completely unpersuasive.

First, there is no evidence to support the statement that Applicant would not have thought to make the modifications. Applicant’s statement is contained in a Declaration that is not in evidence. This cannot serve as a basis for a sound argument.

Second, even if Applicant were considered to have ordinary skill in the art, Applicant’s subjective thought processes are not a determining factor. Examiner must look to what the art as a whole teaches. As pointed out in the rejection, use of special purpose programs to serve as user interfaces are notoriously well known. Before the advent of the web browser, this type of program was the only way to provide access to information over a network. Yet Applicant expects Examiner to completely ignore the myriad of teachings in the prior art and the fact that for years the only way to provide the functionality was to write a dedicated user interface program merely because Applicant says it did not occur to the Applicant to write such a program. This argument is further weakened by the fact that Applicant eventually *did* write such a program. Therefore, it must have occurred to the Applicant that such a program could be written.

10. Applicant argues that the reference cited is actually the claimed invention. There is no evidence to back up this contention. Examiner also notes that this is the first time that Applicant has made this argument. It appears to be somewhat late in the prosecution to make an argument that should have been made in response to the first office action. Be that as it may, Examiner urges Applicant to review the MPEP sections on declarations and affidavits in order to properly file such evidence. Examiner suggests an affidavit or declaration that gives the date of

Art Unit: 3714

publication of Don Best I and date of publication of Don Best II (the current invention). The declaration should also point out the features of each programs and how they differ. Examiner also suggests that the declaration contain copies of any advertising material and users manuals for both programs. This data will allow the Examiner to judge the difference between the two programs and determine if the two are patentably distinct.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

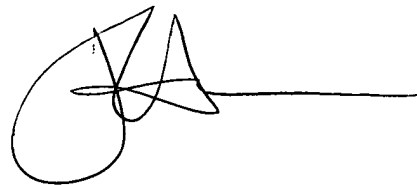
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Jessica Harrison can be reached on (703) 308-2217. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


cbc

JESSICA HARRISON
PRIMARY EXAMINER